UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,554	10/31/2000	Katsumi Nihei	Q61559	7384

7590 10/30/2006	EXAMINER
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ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/699,554	NIHEI, KATSUMI
	Examiner	Art Unit	
	Joseph G. Ustaris	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4 and 8-13* is/are rejected.

7) ☒ Claim(s) *5-7 and 14* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *31 October 2000* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Zigmond et al. (US006698020B1) in view of Alexander et al.

(US006177931B1).

Regarding claim 1, Zigmond et al. (Zigmond) discloses a system and method for

selecting and inserting advertisements or "an advertisement method for presenting

advertisement data, transmitted by broadcasting, to users" (See Figs. 3-5). At the

household or "reception end" is a WebTV box or "receiver" that is able to set "selections

standards" for the user. The WebTV box includes an ad insertion device where it stores

viewer and system information that is used to select advertisements (See Fig. 5,

element 82). The viewer and system information defines "selection standard" such as

"receive time, a receive position, and preference of the user" (See column 10 lines 47-

63). The system then uses the "selection standards" to filter or "select" advertisements

that meet the "selections standards" and proceeds to store the filtered advertisements in

an advertisement repository or "advertisement database" (See Fig 5, elements 82, 83,

84, and 86; column 15 lines 17-23). However, Zigmond does not explicitly disclose

assigning an evaluation value to the stored advertisement data based on a reproduction

time, a reproduction position and preference of the user, extracting the advertisement

data in the order of highest evaluation value, and presenting the extracted

advertisement data to the user in the order of highest evaluation value.

Alexander et al. (Alexander) discloses a system for providing advertisements to

the user. Alexander discloses that stored advertisements (See column 20 line 66 –

column 21 line 5) are assigned a priority value or "evaluation value" (See column 26

lines 45-56) based on a "reproduction time, a reproduction position, and preference of

the user" (column 26 line 61 – column 27 line 7 and column 28 lines 10-21). The stored

advertisements are extracted in the order of highest priority value or "evaluation value"

and presented to the user in the order of the highest priority value or "evaluation value"

(See column 26 lines 45-56). Therefore, it would have been obvious to one with

ordinary skill in the art at the time the invention was made to modify the advertisement

system disclosed by Zigmond to assign a priority value to the stored advertisement data

based on a reproduction time, a reproduction position and preference of the user,

extracting the advertisement data in the order of highest priority value, and presenting

the extracted advertisement data to the user in the order of highest priority value, as

taught by Alexander, in order to improve the opportunities for the commercial

advertisers to reach the targeted users/viewers.

Regarding claim 2, the advertisements have data "representing a period of an

advertisement", wherein the advertisement is only selected, stored, and displayed if it

meets the "selection standards" (See Zigmond column 13 lines 59-67).

Regarding claim 3, the advertisements have data "representing the position of the location of the advertisement target", wherein the advertisement is only selected, stored, and displayed if it meets the "selection standards" (See Zigmond column 14 lines 49-58).

Claim 9 contains the limitations of claim 1 (wherein the WebTV performs the functions of the "advertisement receiving section" (See Zigmond Fig. 5, AD Delivery), "received advertisement database" (See Zigmond Fig. 5, Advertisement Repository), "time, position, and preference obtaining sections" as well as the "advertisement storage processing section" (See Zigmond Fig. 5, viewer and system information; column 10 lines 47-63), "advertisement extracting section" (See Zigmond Fig. 5), and the "advertisement presentation section" (See Zigmond Fig. 5, display)) and is analyzed as previously discussed with respect to those claims. Furthermore, the advertisements are transmitted by content providers or various other AD sources or "advertisement transmitters" (See Zigmond Figs. 3 and 7). The content providers and AD source have "transmission advertisement databases" (See Zigmond Fig. 3 and 7, AD) and inherently have "advertisement obtaining sections" and "advertisement transmitting section" in order to successfully deliver the "advertisement transmission row" (See Zigmond Figs. 2, 3, and 7) to the WebTV box or receiver.

Claim 11 contains the limitations of claims 1 and 9 (wherein the WebTV is the "advertisement receiver") and is analyzed as previously discussed with respect to those claims.

Claim 12 contains the limitations of claim 1 and is analyzed as previously

discussed with respect to that claim. Furthermore, Zigmond discloses that the

advertisement system discussed in claim 1 may also be embodied as a computer

program product on a computer-usable storage medium (See Zigmond column 6 lines

48-67).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond

et al. (US006698020B1) in view of Alexander et al. (US006177931B1) as applied to

claims 1-3, 9, 11, and 12 above, and further in view of Hendricks et al.

(US006408437B1).

Zigmond in view of Alexander does not disclose a method where the "selection

standards" can store key words that are and are not of interest to the user.

Hendricks et al. (Hendricks) discloses a set top terminal that receives programs

or "advertisements" and is able to search through programs that contain key words,

which are and are not of interest to the user. The key words can be stored within a

downloaded thesaurus. Any programs that contain key words that are not of interest to

the user are excluded (See column 31 lines 5-10 and column 32 lines 42-51).

Therefore, it would have been obvious to one with ordinary skill in the art at the time the

invention was made to modify the viewer and system information and AD selection

criteria disclosed by Zigmond in view of Alexander to be able to store key words that are

and are not of interest to the user, as taught by Hendricks, in order to provide a more

accurate filtering process when searching through programs or "advertisements".

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond

et al. (US006698020B1) in view of Alexander et al. (US006177931B1) as applied to

claims 1-3, 9, 11, and 12 above, and further in view of Rakavy et al. (US006317789B1).

Zigmond in view of Alexander does not disclose a method where the

advertisements that are expired and that have been displayed a certain number of times

are deleted from the local cache of the mobile web client.

Rakavy et al. discloses an Advertisement Killer or "advertisement deletion

processing" that purges advertisements that have been stored for a certain time or

"present time outside said period" and advertisements that have been displayed a

number of times or "presented a number of times equal to said number" (See column 12

lines 60-67). Therefore, it would have been obvious to one with ordinary skill in the art at

the time the invention was made to modify the advertisement system disclosed by

Zigmond in view of Alexander to include an Advertisement Killer, as taught by Rakavy,

in order to efficiently use the repository or "advertisement database" by freeing up more

available space for newer advertisements.

Claims 8 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over

Zigmond et al. (US006698020B1) in view of Alexander et al. (US006177931B1) as

applied to claims 1-3, 9, 11, and 12 above, and further in view of Seth-Smith et al.

(4,866,770).

Regarding claim 8, Zigmond in view of Alexander discloses a "plurality of advertisement sections" (See Fig. 2A, group of ADS 20). However, Zigmond does not disclose that each "advertisement section" is repeated thus causing the same "sponsor advertisements" to be repeated in transmission.

Seth-Smith et al. (Seth-Smith) discloses a system and method for communicating video, audio, and data to various clients. Seth-Smith discloses that each data packet is repeated 5 times in a row during transmission or each "advertisement section" is repeated (See Fig. 8; column 15 lines 1-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the "advertisement sections" disclosed by Zigmond in view of Alexander to be repeated, as taught by Seth-Smith, in order to ensure that the data or "advertisements" are successfully received at the user's end of the system.

Claim 13 contains the limitations of claims 8 and 9 and is analyzed as previously discussed with respect to those claims.

Allowable Subject Matter

2.   Claims 5-7 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 5-7, the prior art of record fails to show or fairly suggest assigning higher and lower "evaluation values" based on how well the advertisements meet the "selection standards".

Regarding claim 14, the prior art of record fails to show or fairly suggest an

equation "e" to obtain an "evaluation value".

Response to Arguments

3.   Applicant's arguments with respect to claims 1-14 have been considered but are

moot in view of the new ground(s) of rejection.

Furthermore, applicant argues with respect to claims 1, 9, 11, and 12 that

Zigmond does not disclose receiving advertisement data and storing received

advertisement data that meets selection standards. However, reading the claims in the

broadest sense, Zigmond does meet that limitation of the claims. Zigmond discloses

that a WebTV box or "receiver" is able to set "selections standards" for the user. The

WebTV box includes an ad insertion device where it stores viewer and system

information that is used to select advertisements (See Fig. 5, element 82). The viewer

and system information defines "selection standard" such as "receive time (e.g. local

time of user), a receive position (e.g. city of user), and preference of the user (e.g.

hobbies and interests of user)" (See column 10 lines 47-63). The system then uses the

"selection standards" to select advertisements that meet the "selections standards" and

stores the selected advertisements in an advertisement repository (See Fig 5, elements

82, 83, 84, and 86; column 15 lines 17-23).

Applicant is reminded that although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re*

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JGU
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